

ESTTA Tracking number: **ESTTA546692**

Filing date: **07/03/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Mag Instrument, Inc.
Granted to Date of previous extension	07/03/2013
Address	2001 South Hellman Avenue Ontario, CA 91761 UNITED STATES
Attorney information	Charles A. Kertell Dickstein Shapiro 2 Park Plaza, Suite 900 Irvine, CA 92614 UNITED STATES kertellc@dicksteinshapiro.com Phone:(949) 623-7882

Applicant Information

Application No	85792653	Publication date	03/05/2013
Opposition Filing Date	07/03/2013	Opposition Period Ends	07/03/2013
Applicant	Motorola Trademark Holdings, LLC 600 N. U.S. Highway 45 Libertyville, IL 60048 UNITED STATES		

Goods/Services Affected by Opposition

Class 009. All goods and services in the class are opposed, namely: Mobile phones, smartphones and accessories therefor, namely, power adapters
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2999097	Application Date	12/12/2003
Registration Date	09/20/2005	Foreign Priority Date	NONE
Word Mark	MAG CHARGER		
Design Mark			

Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 1982/09/00 First Use In Commerce: 1982/09/00 Electric flashlight accessories sold together or separately, namely, rechargeable batteries, charger cradles, electrical converters, power cords, flashlight recharger adapters for use with vehicle cigarette lighters, foreign plug adapters Class 011. First use: First Use: 1982/09/00 First Use In Commerce: 1982/09/00 Flashlights and related parts, component parts and accessories therefor, namely replacement flashlight lamps, flashlight mounting brackets

U.S. Registration No.	1154816	Application Date	11/13/1979
Registration Date	05/19/1981	Foreign Priority Date	NONE
Word Mark	MAG-LITE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 011. First use: First Use: 1979/02/22 First Use In Commerce: 1979/02/22 Flashlight		

U.S. Registration No.	1245187	Application Date	06/30/1982
Registration Date	07/12/1983	Foreign Priority Date	NONE
Word Mark	MAG-NUM STAR		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 011. First use: First Use: 1980/01/19 First Use In Commerce: 1980/01/19 Flashlight Bulbs		

U.S. Registration No.	1389804	Application Date	08/26/1985
Registration Date	04/15/1986	Foreign Priority Date	NONE
Word Mark	MINI MAGLITE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 011. First use: First Use: 1984/01/00 First Use In Commerce: 1984/01/00 FLASHLIGHTS		

U.S. Registration No.	1611960	Application Date	06/30/1987
Registration Date	09/04/1990	Foreign Priority Date	NONE
Word Mark	MINI MAGLITE AAA		
Design Mark			
Description of	NONE		

Mark	
Goods/Services	Class 011. First use: First Use: 1987/01/08 First Use In Commerce: 1987/01/08 FLASHLIGHTS AND FLASHLIGHT ACCESSORIES, NAMELY, LAMPS AND BULBS Class 013. First use: First Use: 1987/01/08 First Use In Commerce: 1987/01/08 FLASHLIGHT HOLSTERS

U.S. Registration No.	1655486	Application Date	07/25/1988
Registration Date	09/03/1991	Foreign Priority Date	NONE
Word Mark	MAG-LITE		
Design Mark			
Description of Mark	THE MARK CONSISTS OF A CIRCUMFERENTIAL INSCRIPTION EXTENDING SUBSTANTIALLY AROUND THE HEAD OF A FLASHLIGHT AND BEARING THE WORDS "MAG-LITE". THE DOTTED LINES ARE NOT PART OF THE MARK AND SERVE ONLY TO SHOW THE POSITION OF THE MARK ON THE GOODS.		
Goods/Services	Class 011. First use: First Use: 1979/02/22 First Use In Commerce: 1979/02/22 FLASHLIGHTS		

U.S. Registration No.	1667539	Application Date	07/25/1988
Registration Date	12/10/1991	Foreign Priority Date	NONE
Word Mark	MINI-MAGLITE		
Design Mark			
Description of Mark	THE MARK CONSISTS OF A CIRCUMFERENTIAL INSCRIPTION EXTENDING SUBSTANTIALLY AROUND THE HEAD OF A FLASHLIGHT AND BEARING THE WORDS "MINI-MAGLITE". THE DOTTED LINES ARE NOT PART OF THE MARK AND SERVE ONLY TO SHOW THE POSITION OF THE MARK ON THE GOODS.		
Goods/Services	Class 011. First use: First Use: 1984/01/00 First Use In Commerce: 1984/01/00 FLASHLIGHTS		

U.S. Registration No.	1715086	Application Date	10/10/1989
Registration Date	09/15/1992	Foreign Priority Date	NONE
Word Mark	MAG INSTRUMENT		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1979/02/22 First Use In Commerce: 1979/02/22 BATTERIES, CHARGERS, ELECTRICAL CONVERTERS AND POWER CORDS Class 011. First use: First Use: 1979/02/22 First Use In Commerce: 1979/02/22 FLASHLIGHTS, FLASHLIGHT PARTS, AND FLASHLIGHT ACCESSORIES; NAMELY, BULBS, CLAMPS, HOLSTERS, TRAFFIC WANDS, LANYARDS, KEYRINGS, BATTERY SPRINGS, BULB PROTECTORS, POCKET CLIPS AND LENSES		

U.S. Registration No.	1975632	Application Date	11/19/1993
Registration Date	05/28/1996	Foreign Priority Date	NONE
Word Mark	MAG		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 1992/01/09 First Use In Commerce: 1992/01/09 electric flashlight accessories sold together or separately, namely rechargeable batteries, battery chargers, electrical converters, power cords, charger cradles, flashlight recharger adapters for use with vehicle cigarette lighters, battery packs for flashlights, voltage converters, foreign plug adapters, hardwiring harnesses for adapting flashlight rechargers to land vehicles, boats and airplanes</p> <p>Class 011. First use: First Use: 1992/01/09 First Use In Commerce: 1992/01/09 flashlights and related parts, component parts and accessories therefor, namely replacement flashlight lamps, combination lens holder/anti-roll units adapted to fit the heads of flashlights, flashlight mounting brackets, rubber gripper sleeves adapted to fit on the barrels of flashlights and leather and nylon carrying holsters and belt holders</p>		

U.S. Registration No.	2485515	Application Date	11/05/1997
Registration Date	09/04/2001	Foreign Priority Date	NONE
Word Mark	MAGLITE		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 011. First use: First Use: 1984/05/17 First Use In Commerce: 1984/07/00 flashlights and flashlight accessories, namely, lamps, bulbs, flashlight accessory kits comprising holsters, lens holders, lenses, pocket clips, wrist lanyards and key rings</p>		

U.S. Registration No.	2575768	Application Date	02/05/2001
Registration Date	06/04/2002	Foreign Priority Date	NONE
Word Mark	MAG-LITE		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 014. First use: First Use: 1998/11/00 First Use In Commerce: 1998/11/00 [Clocks]</p> <p>Class 016. First use: First Use: 1998/11/00 First Use In Commerce: 1998/11/00 Decals, pens, and note pads</p> <p>Class 021. First use: First Use: 1998/11/00 First Use In Commerce: 1998/11/00 Coffee mugs and insulated containers for beverages</p> <p>Class 025. First use: First Use: 1986/00/00 First Use In Commerce: 1986/00/00 Clothing, namely, caps, shirts, T-shirts, sweatshirts, and jackets</p>		

U.S. Registration No.	2622179	Application Date	03/12/2001
Registration Date	09/17/2002	Foreign Priority Date	NONE
Word Mark	MAGLITE		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 2001/01/01 First Use In Commerce: 2001/01/01 electric flashlight accessories sold together or separately, namely rechargeable batteries, battery chargers, electrical converters, power cords, charger cradles, flashlight recharger adapters for use with vehicle cigarette lighters, battery packs for flashlights, voltage converters, foreign plug adapters, hardwiring harnesses for adapting flashlight rechargers to land vehicles, boats and airplanes</p> <p>Class 011. First use: First Use: 2001/01/01 First Use In Commerce: 2001/01/01 flashlights and related parts, component parts and accessories therefor, namely replacement flashlight lamps, combination lens holder/anti-roll units adapted to fit the heads of flashlights, flashlight mounting brackets, rubber gripper sleeves adapted to fit on the barrels of flashlights and leather and nylon carrying holsters and belt holders</p>		

U.S. Registration No.	3104551	Application Date	04/29/2002
Registration Date	06/13/2006	Foreign Priority Date	NONE
Word Mark	MAG-LED		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 011. First use: First Use: 2006/02/09 First Use In Commerce: 2006/02/09 Flashlights, LED flashlights, and related parts, component parts and accessories therefor, namely, replacement flashlight lamps, LED lamps and nylon carrying holster and belt holder</p>		

U.S. Registration No.	3105299	Application Date	02/25/2004
Registration Date	06/13/2006	Foreign Priority Date	NONE
Word Mark	MAG		
Design Mark			
Description of Mark	The mark consists of the word "MAG" and the stylized design of a Panther head.		
Goods/Services	<p>Class 009. First use: First Use: 2006/01/11 First Use In Commerce: 2006/01/11 Electric flashlight accessories sold together or separately, namely rechargeable batteries, battery chargers, electrical converters, power cords, charger cradles, flashlight recharger adapters for use with vehicle cigarette lighters, battery packs for flashlights, voltage converters, foreign plug adapters</p> <p>Class 011. First use: First Use: 2006/01/11 First Use In Commerce: 2006/01/11 Flashlights and related parts, component parts and accessories therefor, namely, replacement flashlight lamps, combination lens holder/anti-roll units adapted to fit the heads of flashlights, flashlight mounting brackets, rubber</p>		

	gripper sleeves adapted to fit on the barrels of flashlights and leather and nylon carrying holsters and belt holders Class 025. First use: First Use: 2006/01/11 First Use In Commerce: 2006/01/11 Clothing, namely, shirts, and caps		
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U.S. Registration No.	3265427	Application Date	04/29/2002
Registration Date	07/17/2007	Foreign Priority Date	NONE
Word Mark	MAG-LED		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 011. First use: First Use: 2006/02/09 First Use In Commerce: 2006/05/23 Flashlight accessories, namely, combination lens holder/anti-roll units adapted to fit the heads of flashlights, flashlight mounting brackets, and leather carrying holsters and belt holders		

U.S. Registration No.	3280356	Application Date	04/29/2002
Registration Date	08/14/2007	Foreign Priority Date	NONE
Word Mark	MAGLED		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 011. First use: First Use: 2006/05/23 First Use In Commerce: 2006/05/23 Flashlights, LED flashlights, and related parts		

U.S. Registration No.	3382287	Application Date	04/29/2002
Registration Date	02/12/2008	Foreign Priority Date	NONE
Word Mark	MAGLED		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 011. First use: First Use: 2006/02/09 First Use In Commerce: 2006/05/23 Flashlight accessories, namely, combination lens holder/anti-roll units adapted to fit the heads of flashlights, flashlight mounting brackets, and leather carrying holsters and belt holders		

U.S. Registration No.	3508161	Application Date	02/26/2008
Registration Date	09/30/2008	Foreign Priority Date	NONE
Word Mark	MAG-LED		
Design Mark			
Description of Mark	NONE		

Goods/Services	Class 025. First use: First Use: 2008/02/02 First Use In Commerce: 2008/02/02 Shirts; Long-sleeved shirts
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U.S. Registration No.	4179888	Application Date	04/16/2010
Registration Date	07/24/2012	Foreign Priority Date	NONE
Word Mark	MAG-TAC		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 011. First use: First Use: 2011/08/30 First Use In Commerce: 2011/08/30 Flashlights, flashlight accessories, namely, replacement flashlight lamps, combination lens holder/anti-roll units adapted to fit the heads of flashlights, holsters and belt holders, pocket clips		

Attachments	Notice of Opposition.pdf(97420 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Charles A. Kertell/
Name	Charles A. Kertell
Date	07/03/2013

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

MAG INSTRUMENT, INC.,)	Opposition No. _____
)	
Opposer,)	Application Serial No.: 85/792,653
)	Filing Date: December 3, 2012
v.)	Publication Date: March 5, 2013
)	Mark: MAXXCHARGE
MOTOROLA TRADEMARK)	International Class: 9
HOLDINGS, LLC,)	
)	
Applicant.)	
_____)	

NOTICE OF OPPOSITION

Box TTAB FEE
Commissioner for Trademarks
U.S. Patent and Trademark Office
P.O. Box 1451
Alexandria, VA 22313-1451

Mag Instrument, Inc. ("Mag Instrument"), a California corporation located and doing business at 2001 South Hellman Avenue, Ontario, California 91761, believes that it will be damaged by registration of the alleged mark shown in Application Serial No. 85/792,653 and, through its attorneys, hereby opposes the same. Mag Instrument opposes registration of this alleged mark in all classes for which Applicant has applied which, on information and belief, is only International Class 9.

On information and belief, Application Serial No. 85/792,653 (for "MAXXCHARGE" for mobile phones, smartphones and accessories therefor, namely, power adaptors, in International Class 9) was filed on December 3, 2012 by Motorola Trademark Holdings, LLC ("Applicant"), a Delaware limited liability company with an address at 600 North U.S. Highway 45, Libertyville, Illinois 60048. It was published for Opposition in the Official Gazette on March

5, 2013. Extensions of time for Mag Instrument to oppose, through and including July 3, 2012, have been granted by the Trademark Trial and Appeal Board.

As grounds of opposition, it is alleged that:

1. Since at least as early as September 1982, Mag Instrument has been using the mark MAG CHARGER® in connection with its manufacture, advertising, and sale of flashlights and related products (including rechargeable batteries, charger cradles, electrical converters, power cords, and foreign plug adaptors). Mag Instrument is the owner of United States Registration No. 2,999,097 for MAG CHARGER® in International Classes 9 and 11, which is in full force and effect, and which has become incontestable. Upon information and belief, the term "electrical converters" appearing in the description of goods for said MAG CHARGER® registration is identical in meaning to the term "power adaptors" appearing in the subject "MAXXCHARGE" application.

2. In addition to the above, Mag Instrument has obtained registrations on the following marks using MAG:

MARK		UNITED STATES REG. NO.
1.	MAG-LITE	1,154,816
2.	MAG-NUM STAR	1,245,187
3.	MINI MAGLITE	1,389,804
4.	MINI MAGLITE AAA	1,611,960
5.	MAG-LITE and Circumferential Inscription	1,655,486
6.	MINI MAGLITE and Circumferential Inscription	1,667,539

MARK		UNITED STATES REG. NO.
7.	MAG INSTRUMENT	1,715,086
8.	MAG	1,975,632
9.	MAGLITE	2,485,515
10.	MAG-LITE	2,575,768
11.	MAGLITE	2,622,179
12.	MAG-LED	3,104,551
13.	MAG and Design	3,105,299
14.	MAG-LED	3,265,427
15.	MAGLED	3,280,356
16.	MAGLED	3,382,287
17.	MAG-LED	3,508,161
18.	MAG-TAC	4,179,888

These marks are collectively referred to as the "MAG Family of Marks." Of these marks and registrations therefor, numbers 1-16 have also become incontestable.

3. Mag Instrument has manufactured, marketed, and advertised its flashlights and related products so that the public associates them with the idea of extraordinary design, materials, workmanship, and reliability. In furtherance of that goal, Mag Instrument typically displays its products and the associated marks in its advertising and promotional presentations. At frequent trade shows, Mag Instrument prominently displays many of the MAG Family of Marks, including the MAG CHARGER® mark, in conjunction with the "Mag Instrument" trade name on a booth where its products are exhibited. Mag Instrument distributes full-color

brochures that depict and describe its entire line of flashlights and related products. In addition, many of the MAG Family of Marks, including the MAG CHARGER® mark, appear on the packaging and containers for the flashlights and/or related products and/or on the flashlights themselves. Mag Instrument has spent millions of dollars in advertising and promoting its flashlights and related products.

4. As a result of Mag Instrument's continuous use and promotion of the MAG Family of Marks, including the MAG CHARGER® mark, as well as the distinctiveness of the marks, the purchasing public has come to associate the MAG CHARGER® mark and the other MAG Family of Marks with Mag Instrument as the source and sponsor thereof.

5. Mag Instrument's flashlights and related products bearing the MAG CHARGER® mark, and other products bearing one or more of the MAG Family of Marks, have developed a reputation for high quality. For example, Mag Instrument's products have earned a superb reputation among police officers, firefighters, and other emergency response professionals, as well as among mountaineers, explorers, sports enthusiasts, campers, and others who require the finest products available. Mag Instrument's flashlight and related products are sold in quantity to police and fire departments and other civil-defense agencies. They are also advertised on television, in sports/outdoor magazines, and by high-quality catalog houses. They are sold at retail through various stores, including sporting goods stores, police equipment stores, hardware stores, and mass merchandisers.

6. The Applicant has applied to register "MAXXCHARGE" for mobile phones, smartphones and accessories therefor, namely, power adaptors, in International Class 9.

7. Mag Instrument has used its MAG Family of Marks, including the MAG CHARGER® mark, on flashlights and related products (including rechargeable batteries, charger

cradles, electrical converters, power cords, and foreign plug adaptors) since well before December 3, 2012 – the date Applicant filed its intent-to-use application for "MAXXCHARGE" for mobile phones, smartphones and accessories therefor, namely, power adaptors, in International Class 9.

8. In view of the similarity of the respective marks, and the similarity of the goods, Applicant's use of "MAXXCHARGE" so resembles Mag Instrument's marks and Mag Instrument's use of its marks as to be likely to cause confusion, or to cause mistake, or to deceive.

9. The MAG CHARGER® mark and the other MAG Family of Marks are distinctive and famous marks. Applicant's use of "MAXXCHARGE," if any, as well as its filing of a trademark application for "MAXXCHARGE," occurred subsequent to the MAG CHARGER® mark (and the other MAG Family of Marks) becoming famous and the registration therefor becoming incontestable. Registration of Applicant's alleged mark will cause dilution of the distinctive quality of the MAG CHARGER® mark and the other MAG Family of Marks. If Applicant is permitted to use and register its alleged mark, Mag Instrument will suffer injury to the value of the MAG CHARGER® mark, the other MAG Family of Marks, its product identity, control over its goodwill and reputation, and its ability to move into new markets.

In view of the above, Applicant is not entitled to federal registration of its alleged mark in that Applicant's proposed use is likely to cause confusion, or to cause mistake, or to deceive. Further, Applicant's alleged mark dilutes the distinctive quality of the famous MAG CHARGER® mark and the other MAG Family of Marks.

WHEREFORE, Mag Instrument prays that said Application Serial No. 85/792,653 be rejected, that no registration be issued thereon to Applicant, and that this Opposition be sustained

in favor of Mag Instrument. The appropriate fee under 37 C.F.R. §2.6 is also submitted herewith.

Please direct all future correspondence to the undersigned.

Respectfully submitted,

Dated: July 3, 2012

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By: /Charles A. Kertell/
Charles A. Kertell

Attorneys for Opposer
MAG INSTRUMENT, INC.

CERTIFICATE OF SERVICE

It is hereby certified that a copy of the foregoing document, entitled Notice of Opposition, has been served on the Applicant by mailing a copy on July 3, 2013, via First Class Mail, postage prepaid, to the correspondence address of record in the Patent and Trademark Office, as follows:

William R. Anderson
MOTOROLA TRADEMARK HOLDINGS, LLC
600 North U.S. Highway 45
Libertyville, IL 60048-5343

By: /Charles A. Kertell/
Charles A. Kertell